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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BARE SAID and STEFAN BAEUERLE

Appeal 2016-004663¹
Application 12/973,795²
Technology Center 3600

Before BIBHU R. MOHANTY, NINA L. MEDLOCK, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1–19 and 21. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our decision references Appellants' Appeal Brief ("App. Br.," filed October 14, 2015) and Reply Brief ("Reply Br.," filed April 4, 2016), and the Examiner's Answer ("Ans.," mailed February 3, 2016) and Final Office Action ("Final Act.," mailed April 8, 2015).

² Appellants identify SAP SE of Walldorf, Germany as the real party in interest. App. Br. 2.

CLAIMED INVENTION

Appellants' claimed invention "relates to dynamically measuring business service usage, for example in business software architectures" (Spec. ¶ 1).

Claims 1, 8, and 15 are the independent claims on appeal. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A computer program product comprising a non-transitory machine-readable medium storing instructions that, when executed by at least one programmable processor, cause the at least one programmable processor to perform operations comprising:

receiving a service call relating to completion of a business process, satisfaction of the service call comprising use of resources of a core software platform;

retrieving, from a metadata repository, a service meta-object comprising a business value calculation blueprint associated with the service call, the business value calculation blueprint comprising an algorithm for assigning a business value to the service call, the algorithm comprising a specification of required input data about the service call;

extracting the required input data from at least one of the service call and an application component from which the service call originated;

calculating the business value based on the extracted required data and the business value calculation blueprint; and
promoting the calculated business value.

REJECTION

Claims 1–19 and 21 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

ANALYSIS

Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *See, e.g., Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of these concepts.” *Alice Corp.*, 134 S. Ct. at 2355. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If the claims are not directed to a patent-ineligible concept, e.g., an abstract idea, the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements of the claims are considered “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 566 U.S. at 79, 78).

The Court acknowledged in *Mayo*, that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo*, 566 U.S. at 71. We, therefore, look to whether the claims focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the

abstract idea and merely invoke generic processes and machinery.

See Enfish, LLC v. Microsoft Corp., 822 F.3d 1327, 1336 (Fed. Cir. 2016).

Appellants first argue that the § 101 rejection cannot be sustained because the Examiner has failed to establish a *prima facie* case of patent ineligibility (App. Br. 9–11). Appellants assert that the Examiner failed in the Final Office Action to provide a reasoned rationale that identifies the judicial exception recited in the claims and explains why it is considered an exception, as required by USPTO Guidelines,³ and that the Examiner also failed to consider claim 1 (which Appellants characterize as “representative”), as a whole (*id.* at 10–11). Appellants charge that the Examiner merely asserts that claim 1 is directed to “user business process feedback” without any explanation as to why the subject matter is abstract (*id.* at 10). And Appellants ostensibly maintain that by failing to provide the requisite analysis, the Examiner has denied Appellants a meaningful opportunity to evaluate the merits of the rejection and provide an effective response (*id.*).

Responding to Appellants’ argument, the Examiner provides further detail in the Answer to support the § 101 rejection (Ans. 2–3). There, the Examiner explains that the claims are directed to “business process feedback,” i.e., to an idea of itself, and, therefore, to an abstract idea (*id.* at 3). Then, separately addressing each of the method steps of claim 1, the Examiner further explains that the claims, although presenting a detailed

³ Appellants reference the USPTO’s “July 2015 Update: Subject Matter Eligibility” and the “2014 Interim Guidance on Patent Subject Matter Eligibility,” 79 Fed. Reg. 74618 (Dec. 16, 2014) (App. Br. 9). However, we note for the record that the July 2015 Update was published on July 30, 2015, i.e., after the April 8, 2015 Final Office Action was mailed.

recitation, “merely amount to receiving [data], performing operations on the data using algorithms[,] and outputting that data”— concepts that the courts have identified as patent-ineligible (*id.* at 3 (citing examples of “an idea of itself” from the “July 2015 Update: Subject Matter Eligibility”)).

The Examiner has set forth the statutory basis of the rejection in a sufficiently articulate and informative manner as to meet the notice requirement of 35 U.S.C. § 132. And we find that, in doing so, the Examiner has set forth a *prima facie* case of patent ineligibility. *See In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (The USPTO carries its procedural burden of establishing a *prima facie* case when its rejection satisfies the requirements of 35 U.S.C. § 132 by notifying the applicant of the reasons for rejection, “together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.”).

Quoting the method steps recited in claim 1, Appellants further argue that “[t]his sequence of processes provides an **ordered combination** of features similar to the processes recited in patent-eligible claim 2 in Example 21 of the Guidelines”⁴ and that “[l]ike exemplary claim 2, the

⁴ Exemplary claim 2, which appears at pages 2–3 of Appendix 1 of the July 2015 Update, reads:

2. A method of distributing stock quotes over a network to a remote subscriber computer, the method comprising:
 - providing a stock viewer application to a subscriber for installation on the remote subscriber computer;
 - receiving stock quotes at a transmission server sent from a data source over the Internet, the transmission server comprising a microprocessor and a memory that stores the remote subscriber’s preferences for information format, destination address, specified stock price values, and transmission schedule, wherein the microprocessor

instant claimed features, when taken as an ordered combination . . . provide a particular useful application” (App. Br. 11). That argument is not persuasive at least because exemplary claim 2 was not found patent-eligible merely because it provided “a particular useful application”; nor would that alone have been sufficient for patent-eligibility. *Cf. CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1371 (Fed. Cir. 2011) (“The Court [in *Parker v. Flook*, 437 U.S. 584 (1978)] rejected the notion that the recitation of a practical application for the calculation could alone make the invention patentable.”). Instead, exemplary claim 2 was deemed patent-eligible because it addressed an Internet-centric challenge, i.e., alerting a subscriber with time sensitive information when the subscriber’s computer is offline (App. Br. 11).

Appellants assert that “[e]mbodiments consistent with instant claim 1 provide automated data about actual core software system resource usage to

filters the received stock quotes by comparing the received stock quotes to the specified stock price values;

generates a stock quote alert from the filtered stock quotes that contains a stock name, stock price and a universal resource locator (URL), which specifies the location of the data source;

formats the stock quote alert into data blocks according to said information format; and

transmits the formatted stock quote alert over a wireless communication channel to a wireless device associated with a subscriber based upon the destination address and transmission schedule,

wherein the alert activates the stock viewer application to cause the stock quote alert to display on the remote subscriber computer and to enable connection via the URL to the data source over the Internet when the wireless device is locally connected to the remote subscriber computer and the remote subscriber computer comes online.

enable usage based pricing as well as allowing resources to be focused on the most heavily used software features” (App. Br. 11). But Appellants do not explain how, and we fail to see how, the patent-eligibility of exemplary claim 2 somewhat impacts the patent-eligibility analysis with respect to claim 1. For example, Appellants do not contend that claim 1, like exemplary claim 2, addresses any Internet-centric challenge. Nor do Appellants otherwise explain in what way claim 1 is similar to exemplary claim 2, and how this similarity impacts the analysis under the *Mayo/Alice* framework.

We also are not persuaded of Examiner error by Appellants’ argument that claims recite a particular technique for determining the resource usage of a process, and do not preempt or tie up the alleged abstract idea (*id.* at 12–13; *see also* Reply Br. 13–14).

There is no dispute that the Supreme Court has described “the concern that drives [the exclusion of abstract ideas from patent eligible subject matter] as one of pre-emption.” *Alice Corp.*, 134 S. Ct. at 2354. But characterizing pre-emption as a driving concern for patent eligibility is not the same as characterizing pre-emption as the sole test for patent eligibility. “The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability” and “[f]or this reason, questions on preemption are inherent in and resolved by the § 101 analysis.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (citing *Alice Corp.*, 134 S. Ct. at 2354). “[P]reemption may signal patent ineligible subject matter, [but] the absence of complete preemption does not demonstrate patent eligibility.” *Id.*

Responding to the Examiner’s Answer, Appellants argue that claim 1 cannot be properly characterized as directed to “an idea of itself” because an idea of itself may be a mental process, whereas claim 1 is “a process performed by a ‘programmable processor’ that receives a request [i.e., a service call] requiring the use of software resources,” and cannot possibly be a mental process (Reply Br. 10). Appellants ostensibly maintain that any process that cannot be performed mentally or by a human using pen and paper, e.g., because the claim recites a computer, is, therefore, “clearly rooted in computer technology” and “inextricably tied to computer technology,” and not an abstract idea (*id.* at 10–11). But that argument was expressly rejected by the Court in *Alice*. See *Alice Corp.*, 134 S. Ct. at 2358 (“[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.”); see also *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1098 (Fed. Cir. 2016) (The inability of a human to perform each claim step “does not alone confer patentability.”).

Here, although claim 1 recites physical components, we find nothing in the Specification, nor do Appellants point us to anything in the Specification, to indicate that any specialized hardware or inventive computer components are required. “And after *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.” *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014).

Finally, we are not persuaded of Examiner error by Appellants’ further arguments that claim 1, for example, is patent-eligible because it is similar to other claims that have been deemed patent-eligible, i.e., exemplary

claim 1 in the USPTO’s Abstract Idea Examples issued January 27, 2015)⁵; claim 1 in Example 23 found in Appendix 1 of the “July 2015 Update: Subject Matter Eligibility; and the claims in *DDR Holdings* (Reply Br. 11–13). Addressing each of these “other” claims in turn, Appellants summarily assert that claim 1 is “inextricably tied to computer technology at least because claim 1 is directed to ‘receiving a service call’ where satisfaction of the service call requires ‘use of resources of a core software platform’”; that “claim 1 [similarly] is necessarily rooted in computer technology to overcome the problem of determining the resource usage by a computing process”; and that “the instant independent claims [similarly] are more than a ‘routine and conventional sequence of events’” and are “directed to clearly defined and specific operations relating to improvements in determining the actual usage of core software platform” (*id.* at 11–12). But Appellants offer no persuasive argument or reasoning to explain how the patent-eligibility of these various claims somewhat impacts the patent-eligibility analysis with respect to the claims here at issue.

We are not persuaded for the reasons set forth above that the Examiner erred in rejecting claims 1–19 and 21 under 35 U.S.C. § 101. Therefore, we sustain the Examiner’s rejection.

⁵ Available at: <https://www.uspto.gov/patent/laws-and-regulations/examination-policy/subject-matter-eligibility>.

DECISION

The Examiner's rejection of claims 1–19 and 21 under 35 U.S.C. § 101 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED